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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/486,629	03/01/2000	STEPHEN ROBERT CARKEEK	17762-304-(F	8920

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EXAMINER

WACHTEL, ALEXIS A

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 06/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/486,629

Applicant(s)

CARKEEK, STEPHEN ROBERT

Examiner

Alexis Wachtel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9-15-2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 12, 13, 15, 19, 21-23, 28, 33, 38, 40 and 47-49 is/are rejected.
- 7) ☐ Claim(s) 11, 13, 14, 17-18, 20, 24-27, 29-41, 43-46, 48 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Detailed Action

Response to Amendment

1. Applicant's appeal brief filed on 9-15-2003 has been considered and has substantially overcome the rejections of the previous office action. In view of the Appeal brief filed on 9-15-2003, New grounds of rejection are set forth below. To avoid abandonment of the application, appellant must exercise one of the following options:
(1) file a reply under 37 CFR 1.111 (if this office action is non-final) or a reply under 37 CFR 1.113 (if this office action is final); or,
(2) request reinstatement of the appeal. If reinstatement of the appeal is requested, such requests must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence is permitted. See 37 CFR 1.193 (b)(2).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 4, 7, 13, 21, 23, 28, 33, 38, 40 and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 7, 21 and 23, it is not clear what is meant by the phrase "a top liquid absorbent textile of less than 4 millimeters". It is abundantly clear that Applicant's claimed article is a composite rather than a textile. Therefore it would make no sense to refer to Applicant's article as a "top liquid absorbent textile". At best, Applicant's article is

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a textile composite wherein "the top liquid absorbent textile" would appear to reference the pile surface.

Regarding claims 4,13,21,23,28,33,38,40 and 48, the Applicant uses the term "density" when referring to weights per unit area. The proper descriptive term to use is "basis weight" or weight per unit area. The term "density" is routinely used to label a measure of mass per unit volume, and thus Applicant's usage of the term is improper and indefinite. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999).

Claim Rejections - 35 USC § 102/103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6,8,12,15,19,21,22, 47 and 49 are rejected under 35 U.S.C. 102(a) as anticipated by, or in the alternative, under 35 U.S.C. 103(a) as obvious over 5,725,705 to Nagahama et al.

The preamble limitation "A table or counter mat... for resting cups, mugs or glasses" of claim 1 is not given any patentable weight since said preamble does not appear to limit the structure of the claimed article in any way and additionally constitutes a recitation of intended use.

Nagahama et al is directed to dust control mats and teaches a mat comprising a base fabric, piles implanted on one surface of the base fabric, and an elastomer backing applied to the non-pile surface of the base fabric, wherein the base fabric comprises a base of a woven fabric or a nonwoven fabric and a floss-like nonwoven fiber layer bonded to the base, said floss-like nonwoven fiber layer contains low-melting fibers, and the floss-like nonwoven fiber layer after the pile yarns are implanted is thermally fixed (Col 2, lines 19-27). The elastomer backing layer is made of SBR, NBR or the like (Col 1, lines 31-32). The elastomer or rubber layer has a basis weight range from 500 to 4000g/m² (Col 6, lines 53-54). Additionally, the elastomer backing layer can have an uncured thickness of 1.8mm (Col 7, lines 37-39). An adhesive agent such as ethylene acetate can be applied to the base sheet (Col 6, lines 47-52) wherein the adhesion by curing is carried out at temperatures from 100° to 200° C (Col 6, lines 58-60). The base is made of a nonwoven fabric wherein the fibers used can be any synthetic fiber such as polyester fiber (Col 4, lines 55-57). Said base has a basis weight of 50 to 500 g/m² (Col 5, lines 6-7). Examiner notes that the basis weight includes Applicant's claimed

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value. Said mat expresses characters (Col 3, lines 57-59). Piles implanted on said mat can be made of nylon fiber, cotton fiber, rayon fiber, polyvinyl alcohol fiber, or acryl fiber wherein the fiber length is over the range of from 3 to 20mm (Col 5, lines 64-67, Col 6, lines 1-3).

Per claim 21, Nagahama et al disclose that pile lengths of at least 3mm can be used, thus Nagahama et al's top liquid absorbent textile surface has a height of less than 4mm which is continuous and consistent.

Per claim 22, although Nagahama et al disclose that the rubber layer is cured at 170C (Col 7, lines 35-39), since Nagahama et al enables for the use of the same exact rubber material (nitrile butadiene rubber) (Col 6, line 26) that the Applicant uses, it is reasonable to assume that the rubber layer can be cured at a temperature greater than 170C as claimed.

Per claim 19, the mat can be produced as a unitary structure by simultaneously bonding and curing the rubber backing to the taffeted textile base in a pressurized mold (Col 6, lines 40-46) at temperature from 100° to 200°C (Col 6, lines 58-60).

Although Nagahama et al is silent as to the liquid absorbance capabilities of pile surface, it is fairly reasonable to assume that one of nylon fiber, cotton fiber, rayon fiber, polyvinyl alcohol fiber, or acryl fiber have some moisture absorbance properties. All fibers absorb moisture to at least a minimal degree. These fiber materials are used as the piles in the dust control mat. [T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on 'inherency' under 35 U.S.C.

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102, on '*prima facie* obviousness' under 35 U.S.C. 103 jointly or alternatively, the burden of proof is the same...[footnote omitted]." The burden of proof is similar to that required with respect to product-by-process claims. *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)).

7. Claims 9 and 10 are rejected under 35 U.S.C. 102(a) as anticipated by, or in the alternative, under 35 U.S.C. 103(a) as obvious over 5,725,705 to Nagahama et al in view of "Introductory Textile Science Fifth Edition" by Marjory L. Joseph.

The features of Nagahama et al have been set forth above.

The method limitation of article claim 9 is given no patentable weight with respect to its affect on the structure of the final product since a printing process does not materially differentiate the claimed article's printed structure over the prior art article's printed structure. All methods of printing result in a printed product. Additionally, Nagahama et al's mat is capable of being laundered (Col 3, lines 30-33).

Alternatively, if aforementioned limitations are given weight, Nagahama et al fails to teach printing characters on Nagahama et al's mat via dye sublimation printing at temperatures greater than 170°C. "Introductory Textile Science Fifth Edition" by Marjory L. Joseph is directed to textile technology and teaches the conventionality of sublimatic transfer printing (dye sublimation printing) (pp. 348, Transfer Printing, lines 8-10) wherein dyes are printed on paper to make the desired pattern after which, said paper and fabric to be printed are pressed together at a temperature and pressure that will cause said dyes to sublime on surface of said fabric. It is relevant to point out to

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Applicant that the temperatures at which successful sublimatic transfer printing occurs depends on the specific type of dye and fiber used and as such Applicant's claimed temperatures are known and obvious. It would have been, in addition, obvious to one of ordinary skill in the art at the time the invention was made to have used a sublimatic transfer printing process to print lettering on Nagahama et al's mat, motivated by the desire to use a well known and cost effective process (pp. 349, lines 17-21).

Response to Arguments

8. With regards to claims 1-6, Applicant argues that Nagahama et al shows only two elements: the base (1) and elastomer backing (4).

Claim 1 calls for *inter alia*: a non-slip backing layer; a top liquid absorbent textile surface and an intermediate stabilization and pile support layer joining the backing layer to the textile surface and aiding support of the textile surface. It is abundantly clear that elastomer backing (4) is a non-slip backing layer; piles (2) are the top liquid absorbent textile surface; and the base (1) constitutes the intermediate stabilization and pile support layer.

Regarding claims 15 and 19, Applicant argues that it would not have been obvious to have employed the claimed printing processes to apply a detailed image to the dust mat of the prior art. Applicant speculates that prior art mats failed to provide a top surface which was continuous and consistent so that the textile surface layer substantially maintains relative position for receiving and displaying a detailed image. Applicant does not clarify or define the scope of the phrase "continuous and consistent". As a result, the Examiner fairly interprets the phrase in the broadest sense possible.

Nagahama et al teaches a dust mat with a printed surface that is considered to continuous, consistent and detailed. Applicant additionally states that the Examiner dismissed claim language as not being given patentable weight. The Examiner gives no weight to the method limitations relating to the specific printing processes used since said printing processes are not seen to differentiate Applicant's printed article over the prior art printed article. All methods of printing result in a printed article. In the alternative it would have been obvious to have used the claimed printing processes to impart an image to the mat disclosed by Nagahama et al for the reasons set forth above.

Allowable Subject Matter

9. Claims 13,23,28,33,28,40,48 would be allowed if rewritten to overcome 112 2nd paragraph rejection. Claims 11,13,14,17-18,20,24-27,29-41,42,43-46 and 48 are objected to as depending on rejected base claims.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex Wachtel whose telephone number is 571-272-1455. The examiner can normally be reached on 10:30am to 6:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Glenn Caldarola, can be reached at (571)-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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